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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS A. TODD
and RONALD F. WEBER

Appeal 2009-013697
Application 10/665,955
Technology Center 1700

Before BRADLEY R. GARRIS, LINDA M. GAUDETTE, and
KAREN M. HASTINGS, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 1-60. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

Claim 1 is illustrative of the subject matter on appeal:

1. A fuel additive system, for comprehensive-single –addition improvement of low-quality transportation fuels, comprising:

a) at least one amount of at least one additive component sufficient to effectively enhance biocidal action;

b) at least one amount of at least one additive component sufficient to effectively enhance combustion boosting action;

c) at least one amount of at least one additive component sufficient to effectively enhance corrosion inhibiting action;

d) at least one amount of at least one additive component sufficient to effectively enhance water managing action;

e) at least one amount of at least one additive component sufficient to effectively enhance detergent action;

f) at least one amount of at least one additive component sufficient to effectively enhance solvent action;

g) at least one amount of at least one additive component sufficient to effectively enhance fuel stabilizing action; and

h) at least one amount of at least one additive component sufficient to effectively enhance fuel lubricating action;

i) wherein at least one comprehensive fuel additive may be provided for adding to transportation fuels.

The Examiner maintains, and Appellants appeal, the following rejections:

all of the claims (i.e., claims 1-60) under 35 U.S.C. §112, second paragraph for being indefinite¹; and

claims 1-14, 19-30, 35, 37-42, 44, 45, 47-52, and 54-60 under 35 U.S.C. §103(a) as unpatentable over Cunningham².

The 35 U.S.C. §112 Issues

Did the Examiner reversibly err in determining that the phrase “comprehensive fuel additive” in the ultimate clause (i) of each of claims 1, 7, 19, and 55 renders all of the claims indefinite?

We answer the question in the affirmative.

Did the Examiner reversibly err in determining that the presence of trademarks in claims 15, 31, 36-38, 40-43, and 46-53 renders these claims indefinite?

We answer this question in the negative.

Analysis

We have carefully considered both the Appellants’ and Examiner’s positions regarding the use of the phrase “comprehensive fuel additive” in the ultimate clause (i) of claims 1, 7, 29, and 55 (as well as all claims dependent thereon). Appellants do not separately argue any claims in the group. Accordingly, we select claim 1 as representative. We determine that

¹ The Examiner separated this rejection into two rejections, one for each of the two issues identified below (*see also* App. Br. 9), but the statutory basis of the rejection is the same. Appellants did not disagree with the Examiner’s position that all the claims were rejected under 35 U.S.C. § 112, second paragraph (see Office Communication mailed Aug. 8, 2008).

²Cunningham, US 5,279,626, issued Jan. 18, 1994.

the preponderance of the evidence supports Appellants' position that this phrase does not render the claims indefinite.

The specification informs the meaning of the claims. *See Miles Lab., Inc. v. Shandon, Inc.*, 997 F.2d 870, 875 (Fed. Cir. 1993) ("The test for definiteness is whether one skilled in the art would understand the bounds of the claim when read in light of the specification. If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more.") (citation omitted). As Appellants point out, the Specification defines the phrase "comprehensive fuel additive" (App. Br. 9, 10; Reply Br. 2). Accordingly, the claim phrase read in light of the Specification is clear; the additives listed in clauses (a) through (h) comprise the comprehensive fuel additive referenced in clause (i) (App. Br. 10). Indeed, even the Examiner agrees that this is what the phrase means (Ans. 3, 13). Under these circumstances, we are constrained to reverse this basis of the §112, 2nd paragraph rejection as applied to all the claims.

On the other hand, we agree with the Examiner that the use of the trademarks in dependent claims 15, 31, 36-38, 40-43, and 46-53 to identify various fuel additives renders those claims indefinite. Appellants do not argue any of the claims in this group separately. Accordingly we select claim 36 as representative. Appellants' reliance upon the Eaton Declaration³ (App. Br. 10-12) to establish that the formulations protected by these trademarks are not changed is unavailing. First of all, contrary to Appellants' position, the use of identifiers such as "DCI series products" in claim 36 permits the use of a change in formulation since as the Eaton declaration establishes, a change in formula may indeed result in a name change such as "Lubrizol

³ Edward R. Eaton Declaration of Oct. 16, 2006.

539” changed to “Lubrizol 540” (Eaton Dec. A46, 3.d.). Second, the Declaration states that the fuel additive chemical compositions “are typically protected by trade secret” (*Id.*). Thus, the public is unaware of what is in these additives, and there is no notice to the public as to what is being claimed. Third, the information presented in the Declaration appears to be no more than assertions as to what is customary in the industry (Eaton Dec. *generally*). There is no evidence that such practices are always followed.

Thus, we are not persuaded by Appellants' arguments or the Eaton Declaration. Neither the attorney argument nor the Declaration points us to actual evidence. Without sufficient evidentiary support, the Eaton Declaration statements and the attorney arguments based on them are merely conclusory, and we give them little weight. *See Velandier v. Garner*, 348 F.3d 1359, 1371 (Fed. Cir. 2003) (“[W]hat the Board consistently did was accord little weight to broad conclusory statements that it determined were unsupported by corroborating references. It is within the discretion of the trier of fact to give each item of evidence such weight as it feels appropriate.”).

Accordingly, for these reasons and those set forth by the Examiner in the Answer, we affirm the Examiner’s rejection of claims 15, 31, 36-38, 40-43, and 46-53 under 35 U.S.C. § 112, second paragraph.

The 35 U.S.C. § 103 Issue

Did the Examiner reversibly err in determining that the claimed fuel additive system would have been obvious over the teachings of Cunningham?

We answer this question in the negative.

Principles of Law

In assessing whether a claim to a combination of prior art elements would have been obvious, the question to be asked is whether the improvement of the claim is more than the predictable use of prior art elements according to their established functions. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007). The analysis need not seek out precise teachings directed to the specific subject matter of the claim, for it is proper to take account of the inferences and creative steps that a person of ordinary skill in the art would employ. *Id.* at 418.

“For obviousness under § 103, all that is required is a reasonable expectation of success.” *In re O’Farrell*, 853 F.2d 894, 903-04 (Fed. Cir. 1988).

Analysis

Appellants do not separately argue any claims in the group. Accordingly, we select claim 1 as representative.

We have thoroughly reviewed each of Appellants’ arguments for patentability. However, we are in complete agreement with the Examiner that the claimed subject matter would have been obvious to one of ordinary skill in the art within the meaning of § 103 in view of the applied prior art.

We add the following primarily for emphasis.

Appellants’ argument that the purpose of the Cunningham patent is to improve the shelf life of a fuel additive package and Cunningham does not recognize the problem discovered by Appellants is unavailing (e.g., App. Br. 13; Reply Br. 2). While we agree that the problem faced by an applicant is a relevant factor, a teaching or suggestion of applicant's problem is not always required for a prima facie case of obviousness. An invention may be

obvious for reasons the inventor did not contemplate. *See In re Dillon*, 919 F.2d 688, 693 (Fed. Cir. 1990) (*en banc*) (long standing problem needs evidence).

Furthermore, the Examiner has provided evidence that a comprehensive fuel additive as claimed herein has indeed been suggested by Cunningham which teaches that a fuel additive may have all the claimed ingredients (e.g., *see*, Ans. 12, 13). *See Merck & Co., Inc. v. Biocraft Labs., Inc.*, 874 F.2d 804, 807 (Fed. Cir. 1989) (“That the ‘813 patent discloses a multitude of effective combinations does not render any particular formulation less obvious. This is especially true because the claimed composition is used for the identical purpose taught by the prior art.”). Indeed, Appellants do not specifically refute this factual finding of the Examiner (App. Br.; Reply Br., *generally*).

Furthermore, contrary to Appellants’ arguments, we agree that the Examiner’s position that determining a result effective amount of each of these known additives in order to obtain the known function of each additive would have been within the ordinary level of skill in the art (e.g. Ans. 14, 15) is reasonable.

Accordingly, Appellants have not persuaded us that the Examiner erred in concluding that it would have been *prima facie* obvious for one of ordinary skill in the art, using no more than ordinary creativity, to have modified Cunningham based on Cunningham’s suggestion to include the claimed known fuel additives in result effective amounts to result in a comprehensive fuel additive as required by claim 1.

In the present case, Appellants have not established on this record that the use of the claimed comprehensive fuel additive achieves any new,

unexpected result. Indeed, the use of such a comprehensive fuel additive appears to be no more than the predictable use of combining various known prior art fuel additives for their known functions.

Under these circumstances, Appellants have not shown reversible error in the Examiner's determination that the subject matter of independent claim 1 (as well as all the remaining not separately argued claims) would have been prima facie obvious over Cunningham.

For the reasons stated above and in the Answer, we sustain the § 103 rejection of all of the appealed claims⁴.

The decision of the Examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1).

AFFIRMED

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⁴ Only those arguments actually made by Appellants have been considered in this decision. Arguments which could have been made but that Appellants chose not to make have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2008).